Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SCOTT A. WILBER

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Appeal No. 1998-1589
Application No. 08/388,631

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REHEARING

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Before JERRY SMITH, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON THE REQUEST FOR REHEARING

This is a decision on appellant's Request for Rehearing filed Nov. 7, 2000, requesting rehearing of our decision affirming the examiner's rejection of claims 21-28.

BACKGROUND

The appellant's invention relates to a random number generator and generation method. An understanding of the invention can be derived from a reading of the sole independent claim 21 at issue, which is reproduced below.

21. A random number generator comprising:

a random number generator circuit for generating a random sequence of signals; and

a computer including a means for interfacing with said random number generator circuit, said means for interfacing consisting of one or more of the following: a device driver, a TSR, a portion of the operating system of said computer, and a program stored in the bios memory of said computer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fasang	4,433,413	Feb. 21, 1984
Yokouchi	5,193,198	Mar. 09, 1993
Stankovic et al. (Stankovic)	5,510,698	Apr. 23, 1996 (Filed Aug. 5, 1993)

The MS-DOS Encyclopedia, Article 15: Installable Device Drivers, Section II: Programming in the MS Dos Environment, pp 447-471, 1998.

Claims 21-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fasang in view of Yokouchi, Stankovic and Article 15. We sustained the examimer's rejection in our decision, mailed Aug. 28, 2000.

ON REQUEST FOR REHEARING

This is in response to appellant's request for rehearing of our decision, mailed Aug. 28, 2000, wherein we affirmed the examiner's rejection of claims 21-28 under 35 U.S.C. § 103.

We have carefully considered the arguments raised by appellant in his request for rehearing, however, those arguments do not persuade us that our decision was in error in any respect.

The first argument raised by appellant is with respect to commercial success. (See Request for Rehearing at pages 1-2 and 5-6.) This argument was not raised in the principal brief or the reply brief. Appellant submits a declaration by the inventor, various exhibits with respect to commercial success and an electronic mail communication from Dr. George Marsaglia. These documents were not timely submitted and form no part of the administrative record which was on review at the time of the decision. Therefore, argument thereto is not persuasive with respect to the rehearing of our decision which is based upon the record. 37 CFR § 1.192(a). Furthermore, we note the dates appearing on the exhibits are well before the date of this Board's decision and the date on the communication from Dr. George Marsaglia is well before even the filing of the Appeal Brief. Thus, this evidence could have been presented earlier.

Appellant presents the background with respect to the protracted prosecution before the examiner(s) assigned to this application. (See Request for Rehearing at pages 2-3.) This is a matter to be addressed to the supervisor(s) of the examiner(s) and is beyond the authority of this Board. This argument does not go to error in our decision. Therefore, this argument is not persuasive.

Next, appellant addresses the points alleged to be misapprehended or overlooked by the Board in its decision. (See Request for Rehearing at pages 3-5.) Here, appellant addresses the language used in the decision as it relates to the examiner's answer and the prior art references. Appellant states that the Board is trying to obfuscate within the decision the "fact that the references do not show what it says by several layers of obfuscation." **Id.** at page 4. We strongly disagree with appellant.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in the claim. Here, we find that the language of claim 21 is quite broad. Claim 21 sets forth a broad field of use limitation for "a random number generator" and **not** a computer having a RNG. Therefore, we need only address a RNG. Next, the claim recites "a random number generator circuit for generating a random sequence of signals" which may either hardware or software-based. This is taught by elements 56 and 44 in the Figure 5 of Stankovic. Control element 44 includes sub-elements: microprocessor 50, level shifter 52 and gate drive 54 which are connected to PC 56 via a serial link. It is not explicitly stated in Stankovic what generates the random sequence of signals, but Stankovic states "microprocessor 50 is in turn connected to a personal computer 56 or equivalent to facilitate development of the microcode for random switching." (See Stankovic at column

5, line 24, 10th word - line 27, last word.) Therefore, in our view, the RNG circuit may be either 56, 50 or a combination thereof. Lastly, claim 21 recites "a computer including a means for interfacing with said random number generator circuit, said means for interfacing consisting of one or more of the following: a device driver, a TSR, a portion of the operating system of said computer, and a program stored in the bios memory of said computer." Here, we note that the language of claim 21 does not recite any functional interrelationship of the RNG circuit and the computer with an interface beyond the interface merely "consisting of one or more of the following: a device driver, a TSR, a portion of the operating system of said computer, and a program stored in the bios memory of said computer." If we accept element 56 as the RNG with an output to a serial link to processor 50, then some communication interface via the serial link would be required. The examiner states that

> [b]oth Stankovic and the claimed invention are directed toward devices (random generators) connected to computer ports (see fig. 5 of Stankovic). Clearly, one of ordinary skill in the art would realize that different devices may be connected to a given port. While the examiner agrees that the construction of PRG's and true random generators differs, the language of the claim is not directed toward a true random generators construction, it is directed toward a random generator which is merely connected to a computer port. (See answer at page 4.)

We agree with the examiner. While there is no detail as to the manner or operation of the interface, the examiner maintains that the RNG connected to a port would have been some

required interface to the port, and device drivers were well known interfaces for such uses. The examiner maintains that

> [t]he use of device drivers to control devices connected to a computer, as taught in Article 15, was notoriously well known in the art at the time the invention was made. In fact, most devices, particularly those connected to ports, require that a device drive be installed in the operating system before the device can be used. The examiner agrees that Article 15 does not explicitly teach a device driver for use with a true random generator, however, it would have been obvious to one of ordinary skill in the art that some type of device driver would be required. (See answer at page 5.)

We agree with the examiner.

The examiner further stated that

> [r]egarding claims 21-24, 27, and 28, applicant alleges that Fasang teaches a 'special built-in system' which would not require a device driver for communication with the CPU. The examiner agrees that Fasang teaches a built-in system, however, the combination of Fasang and Stankovic (fig. 5) teaches a system which is connected to a computer port, and would typically require a device driver, such as is taught in Article 15, to be included in the computer's operating system. (See answer at pages 5-6.)

We agree with the examiner. Here, our general agreement with the examiner is based upon the broad language of claim 21 wherein no detail of the operation of the interface has been recited in the language of the claim which would have been more than the mere combination of a interface with a RNG.

With this as a foundation upon which the decision was based, appellant now requests that this Board perform the "courtesy of explicitly pointing out . . . ." (See Request for Rehearing at page 4.) But we note that there is no "computer port" recited in the language

of claim 21 as was expressly recited in the language of claim 1 in the decision, to which we reversed the examiner's rejection. Here, no port is recited in the language of claim 21, therefore, there is no error in our decision with respect to this issue. With respect to the application of the prior art to the invention as recited in claim 21, we have further elaborated the correspondence above.

Rather than request the Board to make a presentation, appellant has the burden of identifying a clear error (points misapprehended or overlooked) in the decision. (See 37 CFR § 1.197(b).) We find that appellant has not identified any points misapprehended or overlooked in the decision.

Appellant points out that the computer in Stankovic is the RNG and is no more than a software-based PRNG. (See Request for Rehearing at page 3.) We agree with appellant. Appellant argues that Fasang teaches a computer including a PRNG. **Id.** at pages 3-4. Appellant argues that the PRNG of Fasang is not connected to any of the ports and does not show or require any interface as claimed in claims 21 and 28. **Id.** Appellant then expressly states "it shows a control unit 44 connected to a serial port or a computer 56." Here, appellant admits that the microprocessor 50 or computer is connected to the port of the PC 56, albeit that any random number generated by either PC 56 or microprocessor 50 would be transmitted in the direction of the gate 42 rather than from the microprocessor 50 to a port on the PC 56. Be that as it may, we disagree with appellant's

individual analysis of each reference and generalization with respect to language of the claimed invention. The express language of claim 21 does not require that the RNG output any value to a separate computer, but the language merely requires an interface between the RNG circuit and a computer within the RNG. From our understanding of the examiner's rejection, a software-based PRNG outputting a value to an outside computer would require some device driver if the value were output on a standard (parallel) port. We agree with the examiner. Therefore, the language of claim 21 is met. We agree with the examiner that this is taught and suggested by the combination of references applied.

As set forth in the decision, the examiner has provided a teaching or convincing line of reasoning why one skilled in the art would have desired to combine the teachings of Fasang, Stankovic and Yokouchi to teach or suggest the invention as recited in the language of claim 21 and its dependent claims. (See decision at pages 7-11.) The decision starts with a finding concerning the scope of claim 21 with respect to appellant's arguments to claims 21 and 28. Therefore, we interpreted the RNG of claim 21 to be broad enough to encompass a PRNG, which appellant admits is taught by Stankovic as a "software-based" PRNG. (See Request for Rehearing at page 3.)

Appellant argues that the interpretation of "random number generator" by the Board in claim 21 to be broad enough to encompass PRNG and true RNG is in error.

(See Request for Rehearing at page 6.) We respectfully disagree. Appellant relies upon appellant's untimely declaration at paragraphs 50-52. This argument is not timely presented and has not been considered.

Appellant further argues that the argument with respect to the distinction between claims 21 and 28 is withdrawn. This attempt to withdraw the argument is also not persuasive since it is not timely presented, and furthermore, it is contrary to the specification at page 1, lines 11-14. Appellant's arguments are directed to "true" RNG, but no such language is present in either claim 21 or 28. Therefore, this argument is not persuasive.

Appellant argues the declaration of the inventor, alleged copying of appellant's invention and comparison of ORION's system. (See Request for Rehearing at page 5.) This evidence has not been considered by the examiner and has not been timely filed for review by the examiner and ultimately by this Board. Further, this argument does not identify any error in our decision. Therefore, argument thereto is not persuasive.

Appellant concludes the arguments stating that it would be a "miscarriage of justice if this inventor, who created two wholly new businesses, would end up with nothing to show for his endeavors because of a Board Decision that is based in obfuscation." Our decision is based on the broad language of the claims and the administrative record. We find no error in the decision,

and appellant has not clearly identified an error based upon the administrative record at the time of the decision. Therefore, appellant's request for rehearing is denied.

In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

JERRY SMITH Administrative Patent Judge	)))))) BOARD OF PATENT
LEE E. BARRETT Administrative Patent Judge	) APPEALS AND) INTERFERENCES))))
JOSEPH L. DIXON Administrative Patent Judge	))

JD/RWK

DUFT, GRAZIANO & FOREST, PC
PO BOX 270930
LOUISVILLE, CO 80027